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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re. patent application of SOUTHERN et al.

Serial No. 10/034,446

Examiner: A. Phi Dieu Tran

Filed: December 26, 2001

Art Unit: 3637

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For: **METHODS FOR ATTACHING SOLID HARDWOOD FLOOR
PLANKS TO CONCRETE FLOOR SURFACES**

Office Action mailed: April 15, 2004

Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

DECLARATION OF JOSEPH J. GRADY, JR.

I, Joseph J. Grady, declare that:

1. I am an expert in the flooring, construction complaint analysis of flooring and flooring substrates, and flooring products that include, but are not limited to, wood parquet and plank flooring, moisture-related flooring problems and substrate testing, and in flooring failures. Attached hereto as Exhibit 1, and incorporated by this reference, is my curriculum vitae, setting forth my training and experience.
2. I have read the captioned patent application, the pending claims (attached hereto as Exhibit 2), the PTO's Office Actions in the above-identified application mailed January 6, 2004, and April 15, 2004 (copy is attached hereto as Exhibit 3), and the following cited references: Greenway U.S.P. 2,088,238 ("the '238 patent"); Searer U.S.P. 5,570,554

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("the '554 patent"); and Taylor et al. U.S.P. 3,740,910 ("the '910 patent"). Respectfully, I disagree that these references, taken together, make obvious the subject matter of the pending claims in this application.

3. The '238 patent, applied for in June 1935 and issued in July 1937, discloses attaching wood flooring to raw concrete surfaces using "mastic" alone, without nails. In the 1930's, the only mastics commonly used in the United States for attaching wood flooring of the kind disclosed in the '238 patent to any surfaces were asphalt-based. The use of such mastics for attaching hardwood plank flooring to concrete surfaces would have failed, meaning that the floor would cup, buckle and otherwise distort over time, in part because these mastics were water-permeable. Even if Greenway had disclosed the use of nails with his product, his product would still have failed, because the mastics available in the 1930's and since then, would have failed. To my knowledge, no successful installations of solid wood plank flooring, where the planks were over three feet in length, took place in the United States at any time until the captioned application brought to the marketplace a successful product for direct attachment to concrete.
4. The flooring disclosed in the '554 patent for attachment directly to concrete, would also have failed because moisture/vapor from the concrete surfaces would have penetrated the wood and caused it to warp, bend and cup. Because the '554 patent teaches that nailing alone would lead to a satisfactory result, the '554 patent leads away from the subject matter of the claims in the pending application. I gather that the

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PTO concedes that the '554 patent teaches no need to use adhesives to attach solid plank flooring to concrete surfaces under any circumstances.

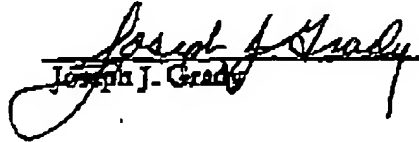
5. The '910 patent does not disclose anything about flooring products. In particular, there is no teaching about attaching solid wood flooring planks to any floor surface, let alone to a concrete floor surface. The '910 patent discloses, at col. 1:54 to col. 2:7, brick clad facings (not solid wood planks) attached to the surface of hard, asphalt-impregnated fiberboard backing sheets, sometimes called sheetrock or drywall, used to make wall surfaces. The resulting products are wall surfaces, not flooring.
6. The PTO's citation to the disclosure at col. 4:46-56 shows that the '910 patent is not analogous to flooring products. There, the '910 patent discloses attaching insulating material, such as sheet-rock or drywall panels, to studs to form a wall in a building structure. These panels are not made of wood, and are not wood planks. The studs are not made of concrete, but of wood. In my opinion, flooring professionals would not look to, or rely on these teachings to come up with the flooring products/processes disclosed in the claims attached as Exhibit 2. The adhesives referred to in the '910 patent are different from, and not interchangeable with, the adhesives identified in the claims of the above-identified application.

I hereby declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful and false statements may

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jeopardize the validity of the application or any registration issued thereon, or any patent to which this verified statement is directed.

This declaration was executed subject to the penalties for perjury under the laws of the State of California, at Los Angeles, California, on 4-29-04, 2004.


Joseph J. Grady

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